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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/424,116 01/06/00 LANG

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EXAMINER

EINSMANN, M

ART UNIT

PAPER NUMBER

1751

DATE MAILED:

05/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/424,116

Applicant(s)

LANG ET AL.

Examiner

Margaret Einsmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 28 March 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 26-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 26-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Applicant's Amendments filed 3/28/2001 have been entered.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 26-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang in view of Konrad.

Lang, U.S. Patent No. 4,025,301, teaches compositions for dyeing hair which contain at least one cationic dye of the formula exemplified which encompasses dyes of formula (I) as claimed, wherein the dye is present in the claimed amounts at the claimed pH's in mediums as claimed, see Abstract and col. 2, lines 2-13. The patentee teaches that the compositions may also

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contain oxidation dyes, and may be mixed with hydrogen peroxide before application to the hair as claimed, see col. 3, lines 42-51. Lang exemplifies various 3-aminopyridine dyes as claimed, see Examples such as 8-15, 20-24 and 27-29. In Example q, Lang exemplifies a composition which contains the dye of Example 14 (a dye of formula (I) as claimed), oxidation bases including p-toluenediamine, p-aminophenol and N-methyl-p-aminophenol sulfate, and couplers including m-aminophenol, all in the claimed amounts in a medium as claimed. The composition is mixed with a hydrogen peroxide oxidant, and is applied to hair in a dyeing method as claimed. Lang does not teach the claimed couplers of formula (I), or the claimed kits.

Konrad, U.S. Patent No. 4,588,410, teaches compositions for dyeing hair which contain a coupler of formula (I), which encompasses couplers of formula (II) as claimed, see Abstract. Konrad teaches that such couplers, particularly the claimed (2'-hydroxyethyloxy)-2-hydroxy-4-aminobenzene, is an improvement over the conventionally used m-aminophenol coupler because it results in more fashionable tones when combined with conventional developers such as p-aminophenols and p-diamines, see col. 2, line 24-col. 3, line 12.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to at least partially substitute the m-aminophenol coupler in the compositions and processes of Lang (which use oxidation bases and direct dyes of formula (I) as claimed), resulting in dyeing compositions and processes as claimed, because Lang does not require any specific oxidation dyes for use in the patentee's compositions, and Konrad teaches that the claimed substituted m-aminophenols have various improvements over the conventionally used m-aminophenol such as

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improved tones when combined with conventional oxidation bases, including the bases exemplified by Lang. The storage of the compositions of Lang as modified by Konrad in kits as claimed would have been obvious to those skilled in the art because such kits are conventional for the storage of two-part oxidative hair dyeing compositions, absent a showing otherwise.

Examiner notes the comparative Examples in the specification which show that two compositions as claimed have increased color uptake as compared two compositions which differ only in that they contain m-aminophenol as coupler instead of 5-amino-2-methylphenol as claimed. This evidence is not deemed persuasive to overcome the above rejection for several reasons.

First, the closest prior art of record, Lang's Example q, was not compared. Lang's composition contains a mixture of oxidation bases and couplers, encompassed by the claims but not present in the compared compositions. It is unclear how these additional dyes effect the overall results. Showings of unexpected results must compare the closest prior art. See *Ex parte Beck*, 9 USPQ 2d 2000 (BPAI 1987); *In re Burkel*, 201 USPQ 67 (CCPA 1979), and *In re Merchant*, 197 USPQ 785 (CCPA 1976).

Second, the evidence is not commensurate in scope with the claims. Particularly, the claims allow for countless mixtures of dyes of formula (I) in combination with any oxidation base and a coupler of formula (II), wherein each component may be present in virtually any amount at any pH. Two combinations as claimed were compared, wherein both combinations contained the same oxidation base and coupler, i.e. p-phenylenediamine and 2-methyl-5-aminophenol. Such a

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limited showing is not representative of the full scope of the claimed invention. Evidence of unobviousness must be commensurate in scope with the claims. See *In re Kulling*, 14 USPQ 2d 1056, 1058 (Fed. Cir. 1990).

Response to Arguments

Applicant's arguments filed 3/28/2001 have been fully considered but they are not persuasive regarding the above rejection. Applicant argues that Konrad does not teach nor suggest the substitution of the coupler of formula I for m-aminophenols for use in compositions comprising both an oxidation base and a direct dye. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Konrad need not show or teach or suggest the substitution of the coupler of formula 1 for m-aminophenols because Lang is applied for the teaching that meta-aminophenols and applicant's direct dyes are used in combination. Thus all of the dyes are used in compositions for dyeing hair. It is prima facie obvious to combine two compositions each taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose. See *In re Kerkhoven*, 205 USPQ 1069, 1072.

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 26-60 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-42 of copending Application No. 09/424,119 in view of Rose.

The claims of the copending application recite hair dyeing compositions, processes and kits which contain and/or use at least one oxidation base in combination with a 3-aminopyrimidine of formula (I) as claimed, wherein each component is present in the claimed amounts in the claimed mediums at the claimed pH's, and wherein the compositions are applied to hair in dyeing methods with oxidants as claimed. The copending claims recite that the composition may contain a coupler, see copending claim 35. The copending claims do not specifically teach the claimed m-aminophenol couplers.

Rose, U.S. Patent No. 4,976,742, teaches m-aminophenols couplers of formula (I) which overlap in scope with those of formula (II) as claimed, and wherein Rose's preferred couplers include those as claimed, see Abstract and col. 2, lines 39-42. Rose teaches that the couplers are

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particularly fast to light and rubbing, and may be combined with conventional developers and substantive dyes (i.e. direct dyes) for dyeing hair, see col. 2, lines 3-9 and 48-51; and col. 3, lines 16-19.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a m-aminophenol coupler as claimed to the compositions, processes and kits of copending application No. 09/424,119, because the claims of the copending application teach that couplers may be added while not requiring any specific couplers, and Rose teaches that the claimed couplers not only are suitable for use with conventional oxidation bases and direct dyes, but also lead to dyeings with good fastness properties.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

1. Applicant's arguments filed 3/28/2001 regarding the above rejection have been fully considered but they are not persuasive. Applicant argues that neither Rose nor copending application 09/424,119 teaches a composition comprising all of the components in applicant's composition. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The rejection did not state that all of the components were in the composition of either. Since 09/424,119 claims the addition of

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a coupler, Rose provides the motivation to choose the particular claimed coupler in combination with at least one oxidation base and the aminopyridine direct dye as claimed in the 09/424,119 application.

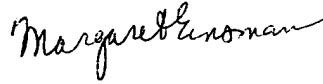
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

~~Any inquiry concerning this communication or earlier communications from the examiner~~
should be directed to Margaret Einsmann whose telephone number is (703) 308-3826. The examiner can normally be reached on Monday to Thursday and alternate Fridays from 7:00 A.M. to 4:30 P.M. The fax phone number for this Technology Center is (703) 305-3599

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



MARGARET EINSMANN

PRIMARY EXAMINER 1751

May 7, 2001
